

REMARKS

In the Advisory Action dated May 15, 2006, the Examiner simply maintained the §102 rejections under Doubler et al. (United States Patent No. 6,692,530) and Daniels et al. (United States Patent Application Publication No. 2004/0122525), without responding to the issues discussed during the telephone interview of March 1, 2006, which issues were also argued in Amendments B and C. Additionally, these issues were also outlined in the Examiner's Interview Summary Sheet (Form PTO 90C). Accordingly, in order to move prosecution forward, Applicants request that the Examiner respond to the following issues:

(1) With regard to the §102 rejection based on Doubler et al., the Examiner should either withdraw this rejection of independent Claim 9 and associated dependent Claims 10, 13-15 and 21, or provide a definition of the term "about" that contradicts Applicants' position that a first component cannot be considered as being positioned "about" a second component if the first component is located within the second component. More specifically, in Figure 1a of Doubler et al., it is Applicants' position that member 20 cannot be considered as being "rotationally and axially adjustable about" member 11, as defined in independent Claim 9. (Instead, member 11 is positioned about member 20).

(2) With regard to the §102 rejection based on Daniels et al., the Examiner should either withdraw this rejection of independent Claims 1 and 9 and their associated dependent claims, or provide evidence that component 90 of Daniels et al., is disclosed as being "expansible" (Claim 1) and/or "flexible" (Claim 9).

(3) With regard to the §102 rejection under Daniels et al. of independent Claim 16 and its associated dependent claims, the Examiner should either withdraw this rejection or explain how component 90 of Daniels et al. is “positioned between the stem and the proximal body,” where the Examiner equated component 18 of Daniels et al. with the “stem” and the Examiner equated either members 94/106 or the distal portion of member 90 with the “proximal body.”

In addition to responding to the three issues outlined above, the Examiner is requested to review and respond to the following arguments, which include expansions upon the arguments outlined above, as well as additional arguments.

Claims 9, 10, 13-19, 21 and 22 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 6,692,530 to Doubler et al. Applicants respectfully traverse this rejection.

As discussed during the telephone interview of March 1, 2006, Applicants respectfully submit that the Doubler et al. reference fails to disclose all of the features of the present invention. More specifically, with regard to independent Claim 9, Applicants respectfully submit that the Doubler et al. reference fails to disclose a modular hip prosthesis that includes, *inter alia*, a proximal body that is rotationally and axially adjustable “about the stem.” With regard to independent Claim 16, Applicants respectfully submit that the Doubler et al. reference fails to disclose a modular hip prosthesis that includes, *inter alia*, a proximal body that is “positioned around the stem.” During the interview, the Examiner agreed that this rejection was overcome, for the reasons set forth below, unless the Examiner discovers a

definition of the term “about” that contradicts that set forth below. However, in the Advisory Action of May 15, 2006, the Examiner simply maintained this rejection without providing a definition of the term “about” that enables the claims to read on the Doubler et al. reference. Accordingly, Applicants request that the Examiner either withdraw the rejection or provide a detailed response to this issue.

One example of an embodiment of the prosthesis defined in independent Claims 9 and 16 is shown in Applicants’ Figures 1 and 2, which embodiment includes proximal body 14 and stem 12. In this embodiment, the proximal body includes a bore 86 (Figure 6B) so that it can be positioned around (or “about”) the stem 12, as shown in Applicants’ Figure 2.

In the device of Doubler et al., the Examiner equated jack screw 20 of Figures 1 and 4-6 with the claimed proximal body, and he equated rod 11 with the claimed stem. *See* December 1, 2005 Office Action, page 3, paragraph 7, line 4-5. As can be seen in Figure 1a of the Doubler et al. reference, member 20 is positioned within member 11. Accordingly, as discussed during the interview, member 20 cannot be considered as the claimed proximal body of independent Claim 9 because it is not rotationally and axially adjustable “about the stem [11].” The most relevant definition of the term “about” in Merriam-Webster’s Collegiate Dictionary defines the term as meaning “in a circle around : on every side of : around.” *See* Merriam-Webster’s Collegiate Dictionary, Tenth Edition, Merriam -Webster Incorporated, Springfield, Massachusetts, page 3, 1994 (copies enclosed with Amendments B and C). Further, the context of the term “about” in Claim 9 also supports this interpretation

because it refers to the proximal body being rotatable “about” the stem, which means that the proximal body is around the stem, and not that the stem is around the proximal body. Accordingly, for at least this reason, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claim 9 and associated dependent Claims 10 13-15 and 21.

With regard to dependent Claim 10, Applicants also separately traverse this §102(b) rejection under Doubler et al. because the Doubler et al. reference fails to disclose that the proximal body includes “a threaded section located along an internal longitudinal bore.” Applicant’s Figure 6B shows one example of a proximal body (14) that includes threaded section 92 along an internal longitudinal bore 86, as recited in Claim 10. In contrast, in the device of Doubler et al., jack screw 20 includes a threaded section 51 on an external surface (see Figure 1A), and therefore lacks a threaded section on an internal bore, as defined in Claim 10. Accordingly, for this reason also, Applicants respectfully request the withdrawal of this §102(b) rejection of Claim 10 under Doubler et al.

With regard to independent Claim 16, the device of Doubler et al. lacks the claimed proximal body that is “positioned around the stem,” as discussed during the interview. As mentioned above, jack screw 10 of Doubler et al., is positioned within stem 11, instead of being positioned “around” the stem, as defined in Claim 16. Accordingly, for at least this reason, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claim 16 and associated dependent Claims 17-19 and 22.

During the interview, the following additional rejection was also discussed: Claims 1, 2 and 4-22 stand rejected under 35 U.S.C. §102(e) as being anticipated by United

States Patent Application Publication No. 204/0122525 to Daniels et al. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Daniels et al. reference fails to disclose all of the features of the present invention. More specifically, the Daniels et al. reference fails to disclose both the “expansible collet” and the locking member having threads to “lock the proximal body and collet together,” as defined in independent Claim 1. With regard to independent Claim 9, the Daniels et al. reference fails to disclose the “flexible sleeve.” Finally, with regard to independent Claim 16, the Daniels et al. reference fails to disclose the “sleeve positioned between the stem and the proximal body.”

With regard to independent Claim 1, the Daniels et al. reference fails to disclose both the “expansible collet” and the locking member having threads to “lock the proximal body and collet together.” First, the Examiner equated either: (1) the entire taper component 90, or (2) the distal portion of component 90 with the claimed “expansible collet.” See December 1, 2005 Office Action, page 4, paragraph 9, line 18-20. One example of an embodiment of the “expansible collet” of Claim 1 is represented by member 18 of Applicants’ Figures 1 and 7A. As can be seen in these figures, member 18 is expansible due to longitudinal slots 118. In contrast, neither the distal end portion nor the entirety of component 90 of Daniels et al. is disclosed as being able to be expanded. During the interview, the Examiner stated that he would review the Daniels et al. reference to determine whether component 90 was “expansible.” Since Applicants were unable to find any disclosure or suggestion that component 90 was “expansible,” and the Examiner has not

provided evidence of this claimed feature, withdrawal of this §102(e) rejection of independent Claim 1 and associated dependent Claims 2 and 4-8 under Daniels et al. is requested.

Additionally, the Daniels et al. reference also fails to disclose the claimed locking member having threads “that engage the threaded section [of the proximal body] to lock the proximal body and collet together” as also defined in independent Claim 1, and as discussed during the interview. In the Examiner’s first interpretation, he equated member 94 of Figure 10 of Daniels et al. with the claimed “locking member.” *See* December 1, 2005 Office Action, page 4, paragraph 9, line 21-22. However, although member 94 does have threads, these threads are not used to lock the proximal body (proximal portion of member 90) and the collet (the distal portion of member 90) together. Instead, both the proximal and the distal portion of member 90 are already formed as a single component, and the threads of member 94 merely lock member 94 and member 90 together.

In the Examiner’s second interpretation, he appears to have equated interdigitating surface 124 of Figure 12 with the claimed locking member. However, the interdigitating surface, which is essentially a surface with radially extending alternating slots/projections, does not have “threads,” as defined in Claim 1. Further, member 124 does not lock the proximal body (members 94 and 106) and the collet (member 90) together. Instead, member 124 merely prevents relative rotation between itself and member 106.

Thus, under either the first or the second interpretation, the locking member of Claim 1 is not disclosed in the Daniels et al. reference. Accordingly, for this reason also,

Applicants respectfully request the withdrawal of this §102(e) rejection of independent Claim 1 and associated dependent Claims 2 and 4-8 under Daniels et al.

With regard to independent Claim 9, the Daniels et al. reference lacks the claimed “flexible sleeve,” one example of which is represented by sleeve (or collet) 18 of Applicants’ Figures 1 and 7A. In the preferred embodiment, sleeve 18 obtains its flexibility from slots 108 of Applicants’ Figure 7A (however, other means of flexibility are also contemplated as being within the scope of the invention). None of the portions of member 90 (which the Examiner appears to have equated with the claimed sleeve) of the Daniels et al. reference are disclosed as being “flexible.” Accordingly, for at least this reason, withdrawal of this §102(e) rejection of Claim 9 and associated dependent Claims 10-15 and 21 is respectfully requested.

With regard to independent Claim 16, the Daniels et al. reference lacks the claimed sleeve that is “positioned between the stem and the proximal body,” as discussed during the interview. One example of Applicants’ sleeve is represented by sleeve (or collet) 18, as shown in Applicants’ Figure 2. As can be seen in this figure, sleeve 18 is radially between stem 12 and proximal body 14 (which is shown in cross-section). In contrast, under the Examiner’s first interpretation of Daniels et al., the distal portion of member 90 (which the Examiner appears to have equated with the claimed sleeve) is not between stem 18 and the proximal portion of member 90. Additionally, using the Examiner’s second interpretation, member 90 is not between stem 18 and members 94/106. In fact, members 94/106 are actually between member 90 and stem 18. Accordingly, for at least this reason,

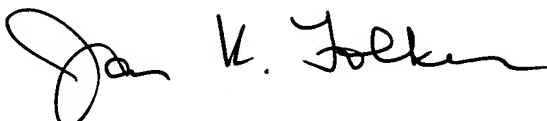
withdrawal of this §102(e) rejection of Claim 16 and associated dependent Claims 17-205 and 22 is respectfully requested.

Applicants also separately traverse the §102(e) rejection of dependent Claims 19 and 20 under Daniels et al. Applicants respectfully submit that member 90, or even the distal portion thereof, is not “radially flexible” as defined in Claim 19, nor does it include “a plurality of longitudinal slots” as defined in Claim 20. Accordingly, for these reasons also, Applicants respectfully request the withdrawal of the §102(e) rejection of dependent Claims 19 and 20 under Daniels et al.

For all of the above reasons, Applicants request reconsideration and allowance of the claimed invention. Should the Examiner be of the opinion that a telephone conference would aid in the prosecution of the application, or that outstanding issues exist, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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